

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) CM06381EI			
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number  10/597,623	Filed  AUGUST 1, 2006			
	First Named Inventor  BAR, ET AL.				
	Art Unit  2617	Examiner  Mapa, Michael Y.			
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <table style="width: 100%; border: none;"><tr><td style="width: 50%; vertical-align: top; padding: 5px;"><input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>46,193</u>  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</td><td style="width: 50%; vertical-align: top; padding: 5px;"><u>/Anthony P. Curtis/</u> _____ Signature  <u>ANTHONY P. CURTIS</u> _____ Typed or printed name  <u>847-538-7588</u> _____ Telephone number  <u>September 10, 2010</u> _____ Date</td></tr></table> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>				<input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>46,193</u>  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>/Anthony P. Curtis/</u> _____ Signature  <u>ANTHONY P. CURTIS</u> _____ Typed or printed name  <u>847-538-7588</u> _____ Telephone number  <u>September 10, 2010</u> _____ Date
<input type="checkbox"/> applicant/inventor.  <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)  <input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>46,193</u>  <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>/Anthony P. Curtis/</u> _____ Signature  <u>ANTHONY P. CURTIS</u> _____ Typed or printed name  <u>847-538-7588</u> _____ Telephone number  <u>September 10, 2010</u> _____ Date				
<input type="checkbox"/> *Total of <u>1</u> forms are submitted.					

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. **SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.**

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UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S): BAR, ET AL.                      GROUP ART UNIT: 2617  
FILED:                      AUGUST 1, 2006      APPLICATION SERIAL NO: 10/597,623  
TITLE:                      APPARATUS AND METHOD OF DIRECT MODE RADIO  
                                    COMMUNICATION

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**REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

In response to the Final Office Action dated June 10, 2009, Applicants respectfully file herewith a Notice of Appeal; and further Applicant requests review of the final rejection in the above-identified application before filing an appeal brief.

Applicants respectfully assert that there is a clear deficiency in the prima facie case and contains a clear error because one or more limitations are not met by the cited references.

***The rejection of Claims 20-33 and 36-39 under 35 U.S.C. §103(a) as being unpatentable over Souissi et al. (U.S. Patent Publication No. 2002/0075941; “Souissi”) in view of TETRA STANDARDS and Aragonés et al. (U.S. Patent Publication No. 2003/0152055) and of Claims 34-35 under 35 U.S.C. §103(a) as being unpatentable over Souissi and TETRA STANDARDS in view of Iwamura (U.S. Patent Publication No. 2004/0184406) should be withdrawn.***

Claim 20 recites a communication method for group-related communications. A mobile station maintains an ordered list of multiple user groups that is used for scanning for ETSI direct mode activity among at least some of the groups, which each communicate using different RF channels. The mobile station periodically samples each channel to determine if there is a direct mode communication on that channel. Depending on user selection, the mobile station may be switched to a different channel. This selection is independent of the relative priorities of the direct mode communications on the different channels.

Generally, the method of claim enables multiple associations to co-exist, each one using a dedicated RF resource, while defining protocol mechanisms that enable detection of the other

associations and if desired joining the detected activity. Souissi discloses a method of reducing collisions for ad-hoc Bluetooth networks that share a common resource (RF spectrum). The ad-hoc networks project hopping patterns, anticipate and attempt to avoid collisions. To perform this, priority allocations are provided to stop messages from the potentially colliding networks or a temporarily increase in error correction for the networks are instituted. In particular, the mobile station scans frequency hopping channels as set by a master's sequence to find/sync with an existing piconet. This is entirely different from the recited method of claim 20.

Applicant respectfully disagrees with the statement in item 4, page 3, of the Final Office Action. The Office Action on page 3 cites to paragraphs [0043], [0053], [0084] and [0090] of Souissi as disclosing maintaining the group set (which has the ordered list of user groups) for scanning for RF activity among the groups and sampling the direct mode channels. The same paragraphs are used in the paragraph bridging pages 3 and 4 to provide the basis for the Office Action insisting that Souissi disclose ETSI direct mode communications.

1) The paragraphs of Souissi disclose that the mobile station scans each of a set of frequency hopping channels for different piconets. However, neither a piconet nor a channel used by the piconet is a user group (although a user group is associated with a channel). User groups have a specific meaning to one of skill in the art, one that is followed by the instant specification. Thus, whether or not particular frequencies used by different piconets are scanned by Souissi, Souissi does not disclose an ordered list of user groups.

2) As the Office Action states in the paragraph bridging pages 3 and 4, Souissi indicates that the mobile station 29 is a member of different piconets 19, 20. The Office Action equates adhoc networks as direct mode communications. Again, this is not true. Adhoc refers to the manner in which communications are established (not prearranged, members can join/leave). Direct mode communication has a specific meaning in the art, one which is used in the instant specification, and describes the manner of communications between devices (directly between devices as opposed to trunked in which communications are routed through the infrastructure).

The rejection misrepresents Souissi. Although the Examiner is entitled to give terms in the claims their broadest reasonable interpretation during examination, any interpretation must be consistent with the specification as well as being with the interpretation that those skilled in the art would reach. (*Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005), *In re Cortright*, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)). Here, the

interpretations of “direct mode communication” and “user group” are neither compatible with the manner in which the terms are employed in the specification nor the interpretation that those skilled in the art would reach.

In *Ex parte* TECHNOFIRST S.A, Appeal 2009-010931, March 5, 2010, the issue centered around the term “complex polynomial function.” In reversing the Examiner, who defined the term as employing complex numbers (a wholly different interpretation from the manner in which it was used in the specification), the Board held that “while giving claim terms their broadest reasonable interpretation is correct and proper, such interpretations need to be made in view of the specification. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1316 (Fed. Cir. 2005). With such a standard, we do not find the Examiner’s alternate interpretations to be consistent with the instant Specification... [t]he Examiner [had] provided nothing to counter his opinion other than a finding of the plain meaning of the term... While “complex” can certainly connote complex numbers, we find no support for such a contention in the Specification.” The use of “direct mode communication” and “user group” in the instant specification is similar.

*In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993), which is often cited by the Office, is inapplicable as the issue in this case revolved around the term “uniform magnetic field.” Unlike the term “reference,” which is commonly known to one of skill in the art, there is no standard definition of “uniform magnetic field” for one of skill in the art. Nor was a definition ever provided in the specification. Van Geuns attempted to read an NMR limitation of the specification to define this term in the claim, which prompted the CAFC holding. However, this holding is not germane to the instant application as standard definitions of the terms “direct mode” and “user group” exist in the art.

3) Souissi is directed primarily towards Bluetooth protocols, with an indication that other short range protocols with comparable features may be used. Direct mode TETRA is not such a protocol - the protocol means, physical limitations, algorithms and the surveillance procedures are entirely different and may not be modified in a like manner as Souissi without extensive further experimentation and modification. Even though the Office Action cites to the TETRA standard, as explained in the instant specification (see, e.g., p. 3, l. 16 – p. 4, l. 27), a mobile station following the TETRA standard *only* addresses one channel and is consequently ignorant of any other TETRA activity that might be taking place on another RF channel, and which may be of interest to the user of the mobile station. Thus, the combination of references, even if able

to be combined and individually showing particular parts of the claim (which they do not), further requires modification of the TETRA standard to enable the method of claim 20.

4) Aragonés is directed towards correcting for degraded audio caused by different problems to enable call conferencing using Bluetooth devices. To this end, Aragonés discloses adding a “switch box” that combines multiple inputs to produce an output and thus can switch between different channels. The Office Action specifically cites paragraph [0041] as disclosing user selection to determine whether to switch to a different direct mode channel when radio frequency activity on the different direct mode radio frequency channel is determined. Besides the above point that Aragonés does not disclose direct mode channels, the paragraph cited only describes an authentication process that prompts the user to select a particular piconet. Aragonés does not disclose that the user selection is prompted by activity on another channel.

Moreover, Aragonés is directed to switching between different active channels for call conferencing whereas Soussi is directed towards avoiding conflict by, e.g., having devices in a lower priority piconet not transmit during predicted collision times. These are entirely different (and conflicting) solutions.

For at least these reasons, the Final Office Action does not present a *prima facie* rejection of the method of claim 20 or the mobile station of claim 30.

Because independent claims 20 and 30 are not properly rejected, the rejection of the dependent claims, which provide additional patentable subject matter, should also be withdrawn.

The Office Action continues to insist that merely because the TETRA DMO specifications state some requirement, that one of skill in the art would be able to produce the result (and takes official notice to this effect). This is far from the case. Merely because a standard exists does not automatically confer to one of skill in the art the ability to create a method that complies with the standard. References cited in the Office Action, such as that to Tetra 4.3.2 and 8.4.2.1, are not related to the disclosure. Tetra 4.3.2 describes call setup, which has nothing to do with when a call is ongoing. Tetra 8.4.2.1 relates to multiplexing of several channels, which is completely different from the claims. For example: regarding claim 22, the Office Action insists that multiplexing is common to share resources. However, claim 22 does not recite that the method generally uses multiplexing – it recites specific sampling that occurs within a particular time period. Neither the TETRA standard nor the cited reference Shrinidhar (which describes extending fiber/LAN across digital subscriber lines by multiplexing – i.e., again

an entirely different system architecture and method) disclose these specific limitations. Claim 23 recites specifics about the time division pattern for the channels. The Office Action points to a section of the TETRA standard that has to do with linearization of the transmitter and clearly has nothing to do with determining the time division pattern for all channels (let alone that this occurs if there is no group activity on any channel). Claim 26 recites specifics about a presence signal. The Office Action points to a section of the TETRA standard that has to do with a pre-emption request. This request, which is used to preempt calls, has nothing to do with a presence signal, which as recited specifies the group to which the direct mode call relates. Claims 27-29 disclose specific features about TETRA timeslots that are not provided in the TETRA standard. Nor, as it does not disclose TETRA communications, does Souissi disclose the specific features disclosed. As above, the Office Action states that the TETRA standard discloses features that are deliberately not specified in the standard. None of the uses of the timeslots recited in the claims is described in the TETRA standard. Nor would one of skill in the art look to Bluetooth protocols to determine how to use the timeslots (and in particular used the timeslots in the specific manner recited in the claims). The procedures recited in claims 24-29 are not in any way referred to by the TETRA standard.

### **Conclusion**

In view of the foregoing remarks, Claims 20-39 have been erroneously rejected. Accordingly, Applicant respectfully submits that the claims clearly and patentably distinguish over the cited references of record and as such are to be deemed allowable. Applicant herein petitions for any extension of time necessary for the filing of this response. Please charge any fees that may be due for this filing to Deposit Account 502117, Motorola, Inc.

SEND CORRESPONDENCE TO:

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